

REMARKS

Allowable Subject Matter

Applicants note with appreciation the allowance of Claims 40-50.

Rejections under 35 U.S.C. §112

The Examiner has rejected Claims 51-65 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states, "Specifically, term 'capable of' is not a positive statement and does not have meaning in any patentable way." Applicants respectfully traverse the rejection.

Independent Claim 51 recites a nanorod barcode, comprising a first segment of a first material; and a second segment of a second material joined longitudinally to said first segment; wherein at least one of the first and second segments is capable of generating emission in response to excitation energy.

To quote from the MPEP, §2173.05(g), "It was held that the limitation used to define a radical on a chemical compound as 'incapable of forming a dye with said oxidizing developing agent' although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). Applicants assert that as the term 'incapable of' has been found to be acceptable patent language, then the term 'capable of' should enjoy the same benefit.

"The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

Applicants assert that "one of ordinary skill in the art" understands what is meant by the recitation of Claim 51, "at least one of the first and second segments is capable of generating emission in response to excitation energy."

If the Examiner still feels that the language used in Claim 51 is indefinite, his suggestions for improvement would be most welcome. To quote from the MPEP §2173.02, "Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Appl. No: 10/659,992
Amdt. dated: January 5, 2007
Reply to Office Action of: October 10, 2006

Dependent Claims 52-65 depend from independent Claim 51 and therefore include all the features and limitations thereof. Furthermore, the dependent claims add further distinguishing features of particular utility. Accordingly, Applicants submit that the dependent claims are also allowable.

CONCLUSIONS

In view of the foregoing remarks, Applicants submit that the application is in condition for allowance. If, however, some issue remains which the Examiner feels may be addressed by Examiner's amendment, the Examiner is cordially invited to call the undersigned for authorization.

Please charge any additional fees, including fees for additional extensions of time, or credit overpayment to Deposit Account No. 12 0690.

Respectfully submitted,
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Dated: January 5, 2007

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